

PATENT
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Applicant: Lentz Confirmation No.: 7721
Serial No.: 09/699,003 Art Unit: 3761
Filed: October 26, 2000 Examiner: Deak, Leslie R.
Customer No.: 21559
Title: METHOD AND COMPOSITIONS FOR TREATMENT OF CANCERS

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
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SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

On July 2, 2009, Applicant filed a "SUPPLEMENTAL STATEMENT UNDER MPEP § 2001.06(c)." The SUPPLEMENTAL STATEMENT included the following remarks:

Further to the Statement under MPEP § 2001.06(c) filed on July 9, 2008, Applicant provides the following additional information.

A related case, U.S.S.N. 09/709,045 was involved in an interference No. 105,413 with U.S. Patent No. 6,379,708 to Howell, et al. Allegations were made by Howell that the Lentz application was invalid under 35 U.S.C. 102, 103, 112, improper inventorship and for inequitable conduct. The Board of Patent Appeals and Interferences ultimately held in Lentz' [sic] favor on all of these issues.

The assignees of the '708 patent to Howell, then filed an action under 35 U.S.C. 146 in the U.S. District Court, District of Columbia, Cytologic, Inc. and Colorado State University Research Foundation v. BioPheresis GMBH and BioPheresis Technologies, Inc. 1:08-cv-00978-CKK.

A motion is pending in the U.S. District Court that the Board of Patent Appeals and Interferences improperly declared the interference on the grounds that the claims were not exactly copied within one year.

Additionally, Applicant draws the Examiner's attention to the Supplemental Information Disclosure Statements filed on October 17, 2007, on March 27, 2008, and March 9, 2009, after a Notice of Allowance was issued and then withdrawn by the Examiner on December 17, 2007, in this application. After the filing of the Supplemental Information Statements it was recognized that some of the cited references may have been known to the Applicant, the undersigned, or the assignee more than three months prior to the filing of the Supplemental Information Disclosure Statements. Any certification under 37 C.F.R. 1.97 should therefore be considered to be withdrawn.

Regarding the statement in the July 2, 2009 filing that “The Board of Patent Appeals and Interferences (“Board”) ultimately held in Lentz’ [sic] favor on all of these issues,” Howell and Lentz each moved for judgment on the basis of priority. The Board, in its “Decision-Priority-Bd.R. 125(a)” (The “Decision”) dated January 9, 2008, denied “the Howell motion and dismiss[ed] as moot the Lentz motion.” (A copy of the Decision is submitted herewith.)

Regarding the allegations of improper inventorship and inequitable conduct in the July 2, 2009 filing, Applicant also points out that the Decision, under the heading “Diligence,” at pages 9-10 states:

In its Motion, Howell contends that Dr. Howell communicated a manuscript of the 1998 Selinsky paper to Dr. Lentz. (Motion at 16).

Howell has not asserted that Lentz derived the invention claimed in the ‘045 application from Howell. (Paper 125 at 2; Transcript of Oral Hearing, November 20, 2007, Paper 151, at 37, II. 4-8).

Howell has not moved for judgment that the Lentz claims are unpatentable because of incorrect inventorship. (Paper 125 at 2; Transcript of Oral Hearing, November 20, 2007, Paper 151, at 38, II. 11-13).

At oral argument, counsel for Howell was unable to explain why communication of the Selinsky 1998 paper to Dr. Lentz would be relevant to determination of priority. (Transcript of Oral Hearing, November 20, 2007, Paper 151, at 37, II. 4-8-38, II. 11-17).⁴

Footnote 4 of paragraph 33 states:

JUDGE TORCZON: We don't have a derivation motion in front of us. We don't have a derivation motion to grant.

MR. HUNTINGTON: Right. But the reason you don't have a derivation motion to grant is because derivation requires transmitting the entire invention to the other party. It's the Gambro case.

JUDGE TORCZON: ... We don't have the derivation in front of us. We don't have an inventorship motion in front of us.

So even assuming that all these smoking guns exist, at this point the only thing we really need to know is, how does that change the priority case? I'm not hearing that.

MR. HUNTINGTON: I don't know what else I can tell you.

The “Selinsky 1998 paper” reference is Selinsky et al., Immunology 94:99-83 (May 1998), submitted in this application on February 28, 2002.

Regarding allegations by Junior Party Howell that Dr. Mark Howell communicated the 1998 Selinsky paper to Dr. M. Rigdon Lentz, Applicant also notes that the Decision, under the heading “B. Communication to Lentz” at page 18 states:

In its Motion, Howell contends that Howell communicated a manuscript of the 1998 Selinsky paper to Lentz. (FF 30). Howell concedes that it is not alleging derivation by Lentz. (FF 31). Howell has not filed a motion seeking judgment against Lentz on the basis that the inventorship of the Lentz patent [sic] is incorrect. (FF 32).

At oral argument, Howell was unable to explain why communication of a partial conception is relevant to our priority determination. (FF 33).

Since Howell has not explained why its allegation that Howell communicated a “partial conception” to Lentz is relevant to the priority determination, we do not further consider Howell’s arguments regarding communication of the manuscript.

In conclusion, the Decision at page 19 states:

We have determined that Howell has not shown reasonable diligence in reducing to practice its invention. Because Howell cannot prevail without a sufficient showing of diligence, we need not and do not reach a decision on Lentz’s motion for judgment based on priority.

Since Howell did not set forth a prima facie showing of diligence in its Motion, we did not consider the Lentz Opposition or the Howell Reply.

Regarding allegations of invalidity under 35 U.S.C. §§ 102, 103, and 112, the Board, in its “Decision on Motions” dated January 25, 2007, denied the following Howell motions: Howell Substantive Motion 2: 35 U.S.C. § 112, ¶1, Written Description (pages 24-30) and Howell Motion 5: 35 U.S.C. §102/103 over JP H2-45064 (pages 30-37).

In connection with the action under 35 U.S.C. § 146 in a case styled *Cytologic, Inc. and Colorado State University Research Foundation v. BioPheresis GMBH and*

BioPheresis Technologies, Inc. (1:08-cv-00978-CKK), Applicant submits herewith papers as filed with the United States District Court District of Columbia.

Regarding the statement that “[a]ny certification under 37 C.F.R. 1.97 should therefore be considered to be withdrawn,” Applicant notes that at least the Lentz publication (Lentz et al., Abstract in the Japanese Society for Apheresis, 15:S31 W4-3 (1996)) and U.S Patent Application Publication No. 2007/0065514 did not qualify for this certification, as filed on March 27, 2008 and March 9, 2009, respectively.

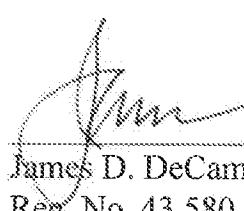
These Information Disclosure Statements were filed after the withdrawal of a Notice of Allowance on December 13, 2007 and Suspension of Prosecution on January 4, 2008. Therefore, the March 27, 2008 and March 9, 2009 Information Disclosure Statements required, under 37 C.F.R. § 1.97(c), either a certification under 37 C.F.R. § 1.97(e) or the fee under 37 C.F.R. § 1.17(p). Because, as stated above, these Information Disclosure Statements did not qualify for a certification under 37 C.F.R. § 1.97(e), the fee under 37 C.F.R. § 1.17(p) was due for the filing of each Information Disclosure Statement. The fee under 37 C.F.R. § 1.17(p) was paid for the Information Disclosure Statement filed March 27, 2008. Applicant submits herewith \$180.00 for the fee due under 37 C.F.R. § 1.17(p) for the Information Disclosure Statement filed on March 9, 2009. The October 17, 2007, statement did not include a certification under 37 C.F.R. § 1.97(e). The references cited on October 17, 2007, March 27, 2008, and March 9, 2009 were considered by the Office on June 8, 2009.

This statement is being filed before the receipt of a first Office action following the filing of a Request for Continued Examination under 37 C.F.R. § 1.114.

If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: Mark S, 3/00


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